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EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,640

Applicant(s)

SZMANDA, JEFFREY P.

Examiner

CamLinh Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 42, 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42,44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is response to amendment filed on 12/20/2004.
2. Applicant amendments to the drawing are acknowledged. Consequently, objection to drawings are withdrawn.
3. Applicant amendments to the specification are acknowledged. Consequently, objection to specification are withdrawn.
4. Applicant amendments to claims 1 –42 and 44 are acknowledged. Consequently, objection to claims 1 –42 and 44 are withdrawn.
5. Applicant arguments about 112 rejections are acknowledged. Consequently, rejections under 35 U.S.C. 112, first paragraph are withdrawn based on these arguments.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Skillen et al (U.S. 6,098,065).

◆ As per claim 1,

Skillen et al (U.S. 6,098,065) discloses a method of supplying advertisement information to a user searching for information comprising:

- “Receiving from the user, a series of search rules comprising facts about an advertisement” See col. 4 lines 5 – 6. The “search rules” as defined in the application, comprises keywords or phrases (paragraph 0035); Skillen provides a search argument that comprises plurality of terms. Therefore, the search rules corresponds to the “search arguments” that received from the user.
- “Accessing a database comprising details of a plurality of advertisements” See col. 4, lines 31 – 40.
- “Using a search engine to apply said search rules to said database” See Fig. 1, element 16, 18, col. 4, lines 31 – 45.
- “Reporting to the user results comprising a subset of the content of said database” col. 4, lines 46 – 48.

◆ As per claim 2, 7, 12, 19, 26, 33,

- “The user experienced said advertisement previously”. Because the search request includes “desired information” (col. 1 lines 42 – 43), therefore, the user must experience with the advertisement or must see/know and show an interested in it in order to make the request.

◆ As per claim 3, 8, 13, 20, 27, 34,

- “The data network comprises the Internet” See Fig. 1, element 14, col. 3, lines 53 – 55.

◆ As per claim 4, 9, 14 - 16, 21 – 23, 28 – 30, 35 – 37, 41, 43,

- “The algorithm of said search engine is selected from a group consisting of deductive reasoning, fuzzy logic and abductive reasoning” See col. 4, lines 14 – 25.

◆ As per claim 5, 10, 17, 24, 31, 38,

Art Unit: 2161

- “ Said advertisement information comprises contact information” referring to the specification “Search results can be in the form of contact information to enable the user to contact the advertiser or the advertiser's designee”. According to col. 4 lines 64 – col. 5 lines 6, a user can connect to the seller by clicking on the page displayed. This page displayed includes a site address. Therefore, the address corresponds to the “contact information”.

♦ As per claim 6, 18, 32,

- “ Said user is a customer” See Fig. 1, the end user can be any type of user. In addition, the phrase “user is a customer” is considered as Nonfunctional descriptive material (See MPEP, section 2106 section VI), and cannot render nonobvious an invention that would have otherwise been obvious. If the prior art suggest that a user is an en user, merely choosing a user is a customer, would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

♦ As per claim 11, 25,

With all limitation as claimed in claim 1 further claims 11, 25 include:

- “Querying the user to obtain one or more search rules” See col. 5 lines 7 – 17, col. 6 lines 4 – 12. The user profile is maintained in the database 48, fig. 2. This information is accessed each time a new search is received. Therefore, the profile is corresponding to additional one or more search rules.

Art Unit: 2161

- “ A first and second search engine to refine the search result” See Fig. 1, element 16, 18, col. 4, lines 49 – 55.

♦ As per claim 39, 42

With all limitations as in claim 1, further claim 39 and 42 include a “Search terms comprising words having targeted connotative significance to a particular demographic segment”. See col. 2, lines 44 – 49.

♦ As per claim 40,

- “ Said user is an advertiser” See col. 5, lines 3 – 6. “ An advertiser” corresponds to the “seller”.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 10, 39 – 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Loeb et al (U.S. 6,421,652).

♦ As per claim 1,

Loeb et al (U.S. 6,421,652) discloses a method for supplying advertisement information to a user searching for said information within a data network, comprising:

- “ Receiving from the user, a series of search rules comprising facts about an advertisement” See Fig. 8, element 820, col. 9 lines 45 – 54. In particular,

- “A series of search rules” corresponds to the responses to the plurality of questions from the user.
 - These responses comprise information about a particular magazine or trade publications that the user interested in, and is advertised by number of ways (col. 9 lines 12 – 19).
- “Accessing a database comprising details of a plurality of advertisements” See col. 5, lines 40 – 48.
 - “Using a search engine to apply said search rules to said database” See Fig. 2, element 260, col. 5, lines 40 – 48. The “Search engine” corresponds to the “search server” 260.
 - “Reporting to the user results comprising a subset of the content of said database” See Fig. 8, element 830, col. 9, lines 54 – 58.
- ♦ As per claim 2, 7, 12, 19, 26, 33,
- “The user experienced said advertisement previously”. Because the advertising can be advertised in different ways such as flyer, or website (col. 9, lines 18 – 19, 24 – 26), the user must experience with the promotion and show an interest in it in order to make the request.
- ♦ As per claim 3, 8, 13, 20, 27, 34,
- “The data network comprises the Internet” See col. 4, lines 14 – 16.
- ♦ As per claim 4, 9, 14 – 16, 21 – 23, 28 – 30, 35 – 37, 41, 44,
- “The algorithm of said search engine is selected from a group consisting of deductive reasoning, fuzzy logic and abductive reasoning” See Fig. 10, col. 12, lines 2 – 6.
- ♦ As per claim 5, 10, 17, 24, 31, 38,

Art Unit: 2161

- “ Said advertisement information comprises contact information” See Fig. 5 – 6, col. 8, lines 45 – 51.

♦ As per claim 6, 18, 32,

- “ Said user is a customer” See Fig. 1, where “customer” corresponds to the “consumer”.

In addition, the phrase “user is a customer” is considered as Nonfunctional descriptive material (See MPEP, section 2106 section VI), and cannot render nonobvious an invention that would have otherwise been obvious. If the prior art suggest that a user is a consumer, merely choosing a user is a customer, would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

♦ As per claim 39, 42

With all limitations as in claim 1, further claim 39 in includes a “Search terms comprising words having targeted connotative significance to a particular demographic segment”. Referring to Fig. 11C, the user must enter their choices by selecting the appropriate answer or type in the answer (col. 13, lines 23 – 28). These responses correspond to the “search terms” that comprising plurality of words.

♦ As per claim 40,

- “ Said user is an advertiser” See col. 1, lines 42 – 53.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb et al (U.S. 6,421,652).

♦ As per claim 11, 25,

With all limitation as claimed in claim 1 further claims 11, 25 include:

- “Querying the user to obtain one or more search rules” corresponds to the questions that to be asked by the controller.

Applicant uses a first and second search engine to refine the search result. Referring to Fig. 10, element 1025 – 1040, Loeb discloses a logic for eliminate the result by providing more questions to be asked to the consumer. As the result, only a certain numbers of magazines are available for certain consumer (See Fig. 11B). clearly, Loeb discloses a method to refine the search result using a search engine. However, Loeb does not clearly disclose two separate search engines. Loeb, refers to another search engine to do the job if the current fails (see Fig. 2, element 262, col. 5, lines 16 – 18, 47 – 48). It is clear that the claimed provision is inherent. Nonetheless, to expedite prosecution, even if the limitation of the above were not inherent, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use multiple search engines to search for information, because it provides more availability of the system to the user in the searching process.

♦ As per claim 12 – 24, 26 – 38 are rejected based on the rejections above.

Response to Arguments

Art Unit: 2161

6. Applicant's arguments filed 12/20/2004 have been fully considered but they are not persuasive.

♦ As per claim 1, Applicant argues that the Skillen reference fails to disclose the “details comprising a plurality of advertisements” as specified in claim 1. The Examiner respectfully disagrees.

Referring to col. 2, lines 11 – 33, the user uses the search engine to search for information, and the invention is manifested by an advertising system. The search result is a best-fit product advertisement based on user input (col. 5, lines 50 – 57). Clearly information that the user searches for is advertising information

♦ As per claims 2, 7, 12, 19, 26, 33, Applicant argues that the Skillen reference fails to disclose the “use’s prior experience regarding advertisement” as specified in claim 2. The Examiner respectfully disagrees.

Referring to page 4 of the Remark, applicant stated that there are numerous ways for the user experiences, and this experience allows the user to perform the search. In the instant reference (Skillen), also allow the user to retrieve information in the advertising system using user preferences or the history of searching. Clearly, these are also ways for user to experience with the advertised item in order for the user to search for such item.

♦ As per claims 4, 9, 14 – 16, 21 – 23, 28 – 30, 35 – 37, 41, 44, Applicant argues that the prima facie case of anticipation has not been made. The Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., deductive reasoning, fuzzy logic and abductive reasoning) are not recited in the rejected

Art Unit: 2161

claim(s). The claim language clearly stated that “selected from a group” not “consisting of”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

♦ As per claim 1, Applicant argues that the Loeb reference fails to disclose the “details comprising a plurality of advertisements” as specified in claim 1. The Examiner respectfully disagrees.

Referring to col. 9, lines 10 – 53, Loeb clearly discloses that the system is an advertising system, so that the information can be advertised to the user in numerous ways.

♦ As per claims 4, 9, 14 – 16, 21 – 23, 28 – 30, 35 – 37, 41, 44, See responses above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2161

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272-4024.

The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272 - 4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Cam-Linh Nguyen
Art Unit 2171


FRANTZ COBY
PRIMARY EXAMINER

LN